

09/845,597

#15

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Antoni P. Tomsia et al.

Appl. No.: 09/845,597

Filed : April 30, 2001

Title : Glass/Ceramic Coatings for Implants

Grp./Art Unit: 1775

Examiner: Sperty, Arden B.

Docket No.: IB-1627



RECEIVED  
AUG 29 2003  
GROUP 1700

**INTERVIEW SUMMARY RECORD**

All participants:

- 1) Deborah Jones
- 2) Charles R. Nold

Date of Interview: July 16, 2003

Type: Telephonic

Exhibit shown or conducted: no

Claims discussed: all

Identification of Prior art discussed: Provisional patent application 60/201,556

Agreement with respect to the claims: no agreement was reached

**REMARKS**

This interview summary record is being submitted on August 15, 2003. Entry into the record is respectfully requested.

Applicant's requested the interview and provided four talking points for discussion.

The Examiners refused to tell Applicant's what was wrong with the specification, and specifically state how the specification does not meet the requirement of 35 U.S.C. 112 first paragraph. Applicants reminded the Examiners four times that they had a duty to explain how the specification was "deficient", but the Examiner's would not come forth with any reason, merely stating that a compilation of references "is not a specification".

The Examiners own interview summary record shows the mistake the Examiners have made in this examination when they repeatedly state" Counsel is graciously invited to show support in the provisional application for the claimed invention" and "Counsel was invited to show support in those documents for the claimed invention, not just one element".

At one point, Henry P. Sartorio asked the Examiners, if , upon examination of the provisional, was it true that they really couldn't see support for the invention? This question drew no response, except that Deborah Jones said she would look at it again.

The premature finality was not discussed.

RECEIVED  
AUG 29 2003  
GROUP 1700

Respectfully Submitted,

CRN  
Charles R. Nold  
Reg. No. 46,470

Ernest Orlando Lawrence Berkeley  
National Laboratory  
One Cyclotron Road  
Berkeley, CA 94720  
Telephone No. 510 486-6503

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Antoni P. Tomsia et al.

Appl. No.: 09/845,597

Filed : April 30, 2001

Title : Glass/Ceramic Coatings for Implants

Grp./Art Unit: 1775

Examiner: Sperty, Arden B.

Docket No.: IB-1627



RECEIVED  
AUG 29 2003  
GROUP 1700

## INTERVIEW SUMMARY RECORD

## All participants:

- 1) Arden B. Sperty
- 2) Deborah Jones
- 3) Charles R. Nold
- 4) Henry P. Sartorio

Date of Interview: July 16, 2003

Type: Telephonic

Exhibit shown or conducted: no

Claims discussed: all

Identification of Prior art discussed: Provisional patent application 60/201,556

Agreement with respect to the claims: no agreement was reached

REMARKS

This interview summary record is being submitted on August 15, 2003. Entry into the record is respectfully requested.

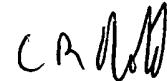
This interview took place approximately 5 hours after the first interview, and was thus the second interview of the day.

Deborah Jones said that the claims were not supported in two limitations:

1. Ms. Jones stated that the provisional only had support for the recitation of a glass/Hydroxyapatite mixture of 50/50.
2. Ms. Jones stated that the provisional only had support for the glass/hydroxyapatite layer being the outer layer.
3. No other reasons were given.

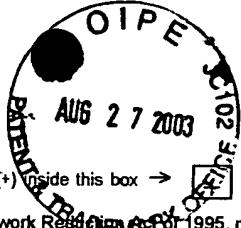
The premature finality was discussed. The reason given for the premature finality was the following: The provisional specification consisted of four journal articles. These four journal articles were cited by applicant on an IDS submitted with the application. The Examiner was not told by applicant that the provisional application consisted of four journal articles that were cited on an IDS. Thus, when the Examiner discovered this, after doing a first office action, a Final Rejection was deemed proper. There was no agreement between the Examiner and applicant on this theory.

Respectfully Submitted,



Charles R. Nold  
Reg. No. 46,470

Ernest Orlando Lawrence Berkeley  
National Laboratory  
One Cyclotron Road  
Berkeley, CA 94720  
Telephone No. 510 486-6503



Please type a plus sign (+) inside this box →

Approved for use through 09/30/2000. OMB 0651-0031  
Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

1775

## TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

5

Application Number	09/845,597
Filing Date	April 30, 2001
First Named Inventor	Antoni P. Tomsia
Group Art Unit	1775
Examiner Name	Sperty

Attorney Docket Number IB-1627

### ENCLOSURES (check all that apply)

<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Assignment Papers (for an Application)	<input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment / Response	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition Routing Slip (PTO/SB/69) and Accompanying Petition	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input checked="" type="checkbox"/> Additional Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	<input type="checkbox"/> 1. two interview summary records, both for July 16, 2003
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Small Entity Statement	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Response to Missing Parts/ Incomplete Application	<input type="checkbox"/> Remarks	
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		

RECEIVED  
AUG 29 2003  
GROUP 1700

### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Charles R. Nold; Lawrence Berkeley National Laboratory
Signature	
Date	8/15/03

### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on this date: 08/15/2003

Typed or printed name	Charles R. Nold
Signature	
Date	8/15/03

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.